

molded by hand with ease. (Col. 2, line 44-45) The putty includes a plasticizer in an amount sufficient to achieve the desired level of softness and moldability and typically ranges from about 30% to about 50% by weight based on the total rubber and unvulcanized rubber content of the putty, or from about 2 to about 25 % by weight, based on the total weight of the putty. The resulting putty is described as soft (col. 3, line 14), conformable (col. 1, line 27), moldable (col. 1, line 64), and pliable (col. 3, line 14).

The present invention, in contrast, relates to a flexible, solid, intumescent composition which is flexible, solid, and capable of being applied in various shapes including sheets, extruded strips and other profiles. The composition acts as a seal and is especially adaptable as a fire resistant glazing strip for metal and wood window frames, doors, dampers and shutters, and may also provide sealing where items such as plastic pipes and electrical cables pass through openings. The material of the present invention, in contrast to the Welna putty, however, cannot be shaped or molded by hand with ease.

The inventive composition may include a plasticizer, but the present application explains that the amount of plasticizer should be limited to prevent the composition from becoming too soft or putty-like. (See page 7, lines 5-6) For example, Examples 1 and 2 include 1.08 wt-% plasticizer (Santicizer 141) (see Tables 2 and 4), and Example 5 includes 1.01 wt-% plasticizer (see Table 9). Thus, the present invention contains a very small amount of plasticizer compared to the putty described in the cited reference, and as a result, has a softness value from about 0.01 to about 3.75 mm.

The absence or small quantity of plasticizer in the present invention is critical because it results in a composition having a softness value of less than 3.75 mm, and this range of softness value is critical because it allows the material to be used for a wide variety of end use application for which a putty would be ill-suited. For example, the present application explains that the composition of Example 5 can be extruded into various complex shapes and has good flexibility, i.e., can be wound on a tape case or hub.

The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. Applicant has reviewed the cited Welna reference and has found no reason, express or implied, in the reference or in the knowledge generally available to one of ordinary skill in the art to modify the cited reference. It therefore follows that reference fails to suggest the desirability of such a modification. More specifically, even though the putty of Welna may be capable of being modified to have a softness value from 0.01 to about 3.75 mm as defined in independent

claim 1, there is no suggestion or motivation in the reference to do so. Rather, the reference has its own utility and is complete and functional in itself, so there would be no incentive to modify the reference.

While applicant acknowledges that judgement of obviousness is based on the level of ordinary skill in the art at the time the claimed invention was made, the Examiner has failed to support the conclusions of obviousness with any reasoning other than what was learned from the invention at issue. It is impermissible to use hindsight to modify the prior art to argue an invention is obvious. There must be something in the prior art that suggested the modification of the particular prior art other than hindsight gained from knowing that the inventor chose to modify a particular feature in a particular way.

Moreover, a statement that modification of the prior art to meet the claimed invention would have been known is not sufficient to establish a *prima facie* case of obviousness without some objective reason to make the modification. The Welna reference fails to provide such reasoning and the Examiner has not presented a convincing line of reasoning supporting any of the obviousness rejections.

Similarly, claim 13 is believed to be patentable over the Welna patent in view of the and the cited Michaeli reference because there is no teaching or suggestion to use any process to prepare a flexible, solid fire sealing composition having a softness value from about 0.01 to about 3.75 mm.

For the reasons set forth above, it is the applicant's position that the rejections of claims 1-12 based on Welna, and claims 13-15 based on Welna in view of Michaeli are improper and should be withdrawn. Reconsideration is requested.

If the Examiner believes there are any outstanding matters in the present application which could be resolved with a telephonic conference, the Examiner is encouraged to contact applicants' undersigned representative.

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Respectfully submitted,

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